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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,172	10/12/2001	Darren Kenneth Rogers	1477(Touchstone)	1953

7590 03/26/2003

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EXAMINER
MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
1714	6

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,172	ROGERS ET AL.	
	Examiner	Art Unit	
	Margaret B. Medley	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
4)☐ Interview Summary (PTO-413) Paper No(s) _____
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other.

DETAILED ACTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 5, 7, 9 and 11-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 4-5 of co-pending Application No. 10/046,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because the surface area of the instant claims would not be excluded from the claims of the co-pending application claims and the thermal conductivity of the co-pending application claims would not be excluded from the instant claims and therefore would not make a patent distinction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3, 5-7, 9 and 11-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-5 and 17 of co-pending Application No. 09/802,828. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the surface area of the instant claims would not be excluded from the co-pending application claims and the thermal conductivity of the co-pending application claims would not be excluded the instant claims and would not be patentable distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harnett 3,309,437 in view of Koppelman 4,127,391 combined with Madley et al (Madley) GB 1,489,690 and Kirk-Othmer.

Harnett teaches a porous based product having compressive strength typically in excess of 5,000 psi (note column 4, lines 1-9) when heated to 950^0 C and an apparent density of 0.93 g/cc (note Table 1 for Examples 4 and 5) and further graphitizing (note column 5, lines 20-44) which anticipates claims 1-4 of Applicant. The apparent density of 0.93 g/cm of patentees renders obvious the apparent density of between about 0.1 and about .08 g/cm^3 of applicants. It is the examiner's position that "about .08 g/cm" read on 0.93 g/cc. Harnett is silent to the coal-based product having a free index swell of between about 3.5 and about 5.0, and preferably between about 3.75 and about 4.5.

It would be obvious to the artisan in the art to use a coal based product as the starting material for the coke product in view of Koppelman and a coal with swelling index between 3 and 9 in view of Madley and Kirk-Othmer. Koppelman teaches coke produced from bituminous coal, column 1, lines 17-68, Examples 1-2 and the Table at column 11. It is the examiner's position that since coke is produced from coal, it is a coal base product.

Patentees Madley teaches the artisan in the art that by varying the pretreatment conditions, e.g., temperature and reaction time, the swelling properties of a specific coal can be controlled to a substantial degree for the subsequent use of the coal in further process step, note page 1, lines 69-75. Madley further teaches a coal having a swell index of 3.5 which encompass the about 3.5 and about 5.0 range, and suggest the preferred range of about 3.75 and about 4.5 of the instant claims, note Madley the example on page 2, lines 32 to page 3 line 10.

The Kirk-Othmer article teaches the artisan in the art that it is state of the art knowledge that best cokes come from coals having swelling indexes between 4 and 9. the last paragraph on page 455 of Vol. 6. The article further discloses application of Coal Petrology and Petrography, pages 429 to page 434 of Vol. 6, particularly figure 3 at page 431 for swelling indexes of coal and Table 4 for the coal classification. It would be obvious to the artisan in the art to use the bituminous coal of Koppelman and particularly a coal having 3.5-9 swell index of the secondary references as the starting material coal of the primary reference having a swell index of between 4 and 9 to produce the best coke.

With respect to claims 7-12 being a filter, Harnett teaches that formed bodies are used for insulating blocks for furnaces and reactors, filter, etc. (note column 3, lines 12-22) and that the core products are formed inside containers made of graphite, stainless steel or cardboard (note column 2, lines 4-11) further teaching that it products may be used as filters further rendering the instant claims obvious with the teachings of the secondary references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER

M. B. Medley/mn
March 25, 2003